

REMARKS

In the Specification, paragraph [0048] has been amended to correct the reference numeral used in FIG. 5 that was objected to by the Examiner (Office Action page 2).

Claims 1, 3, 4, 6 through 9, 11, 12, 14 through 17, 19, 20, and 22 through 24 are currently pending in the application.

Claims 2, 5, 10, 13, 18, and 21 have been canceled.

This amendment is in response to the Office Action of May 18, 2004.

Information Disclosure Statement(s)

Applicants are enclosing a courtesy copy of the Supplemental Information Disclosure Statement filed on July 17, 2002. Applicants respectfully request that the information cited on the PTO-1449 be made of record herein.

Claim Objections

Claims 2, 10, and 18 are objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants have canceled such claims to advance the timely prosecution of the application to issue.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 24 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 5, 13, and 21 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have canceled such claims to advance the timely prosecution of the application to issue.

Claims 1 through 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112. The Applicants have amended the claims to distinctly claim the subject matter which Applicants regard as the invention as “a multilayer adhesive including . . . a first outermost adhesive layer . . . and a second adhesive layer disposed between the tape and the first outermost adhesive layer, the second adhesive layer comprising a mixture of electromagnetic radiation-curable components so that when exposed to radiation the second adhesive layer performs at least one of curing onto portions of the first outermost adhesive layer or losing adhesive properties for facilitating peeling of the flexible film material from at least a portion of a surface of a semiconductor device”. MPEP 2173.05(i) “OR” TERMINOLOGY Therefore, presently amended claims 1 through 24 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Weng et al.(U.S. Patent 5,972,234)

Claims 1 through 24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Weng et al. (U.S. Patent 5,972,234).

Applicant assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Turning to the cited prior art, Weng et al. describes a method for marking a semiconductor surface. Weng et al. describe a polymeric tape can be provided that is suitable for ablative photodecomposition. Column 4 lines 25-40. In other words, the mark which is to be

formed in the semiconductor surface is first formed as a cavity through the tape using “high-intensity energy beams such as ultraviolet light or laser.” Column 4 lines 32-33; *See also* column 2 lines 63-63, column 3 lines 6-11, column 3 lines 22-23, column 3 lines 27-30, column 3 lines 39-40, column 4 lines 52-54. After the mark has been formed *through* the tape, the tape is applied to the semiconductor surface. Column 4 line 57 – column 5 line 7. Finally, the mark is formed in the semiconductor surface by etching the semiconductor in the area exposed by the mark formed in the tape. The tape protects the rest of the semiconductor surface from the etchant, such that the mark in the tape is patterned into the semiconductor surface. Column 5 lines 8-25. Finally, the tape is removed from the surface of the semiconductor, leaving the mark formed by the etchant. Column 5 lines 27 – 37. The tape has a thickness of about 0.5 mm and can be provided with an adhesive backing or without an adhesive backing. Column 5, lines 38-41. A suitable adhesive may be an acrylic type polymer. Column 4, lines 63,64.

Applicants assert that the Weng et al. reference cannot and does not anticipate the presently claimed inventions of presently amended independent claims 1, 9, and 17 under 35 U.S.C. § 102 because the Weng et al. reference does not identically describe each and every element of the presently claimed inventions in as complete detail as contained in the claims. For instance, the Weng et al. reference does not identically describe the elements of the presently claimed inventions of presently amended independent claims 1, 9, and 17 calling for “a tape comprising a flexible film material . . . and a multilayer adhesive” In contrast to the presently claimed inventions of presently amended independent claims 1, 6, and 17, the Weng et al. reference, at best, describes a tape having one single adhesive layer, not a tape having multilayer adhesive. Therefore, the Weng et al. reference cannot and does not anticipate the presently claimed inventions of presently amended independent claims 1, 9, and 17. Accordingly, such claims are allowable as well as the dependent claims therefrom.

Further, Applicants assert that to include radiation-curable components into any adhesive layer formed in the tape disclosed by Weng et al. would render the invention inoperable. Specifically, applying radiation would *cure* the adhesive layer, which would prevent a pattern from being formed through the tape. Therefore, no mark could be formed through the tape by an ablative photodecomposition process if the adhesive layer of the tape were to include radiation-curable components. Applicants respectfully assert that a tape comprising an adhesive layer

including radiation-curable components is not “any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser.”

Additionally, Applicants assert that the Weng et al. reference merely describes a photodecomposition process employing an excimer type laser for ablating the polymeric based tape. The Weng et al. reference contains no description whatsoever as to how an excimer laser affects the adhesive. Applicants assert that absent any description as to how an excimer laser affects the adhesive used with the tape, any rejection based upon the Weng et al. reference is based solely upon Applicants’ disclosure, not the cited prior art. In any event, Applicants assert that absent any description as to the affect of an excimer laser on the adhesive in the Weng et al. reference, the Weng et al. reference cannot and does not either expressly or inherently identically describe each and every element of the presently claimed inventions of presently amended independent claims 1, 9, and 17 calling for “a tape comprising a flexible film material and a multilayer adhesive”.

In summary, Applicants assert that Weng et al. cannot and does not anticipate the presently claimed inventions of presently amended independent claims 1, 9, and 17 for the reasons set forth herein.

Applicants submit that claims 1, 3, 4, 6 through 9, 11, 12, 14 through 17, 19, 20, and 22 through 24 are clearly allowable over the cited prior art.

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Applicants request the allowance of claims 1, 3, 4, 6 through 9, 11, 12, 14 through 17, 19, 20, and 22 through 24 and the case passed for issue.

Respectfully submitted,



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Enclosures: Copy of post card, Transmittal Form;
Supplemental IDS; Form PTO-1449;
and 1 reference filed July 17, 2004

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